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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,099	07/30/1999	RENATO CARETTA	07040.0041	8940

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EXAMINER:

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 10/07/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/364,099

Applicant(s)

CARETTA, RENATO

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Note: Applicant is advised that although the first page of the July 15, 2003 amendment indicates that claims "61-85" are to be added, there were no claims 76-85 presented. The only new claims presented were claims 61-75.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 43-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 43 as amended newly refers to "at least a first series of strip sections and at least one second series of strip sections." The original disclosure, however, (at least upon review by the examiner) only refers to a first and a second series of strip sections, not "at least" a first or "at least one" second as now claimed. As such, it is not considered that this new language was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. Analogous instances of lack of description/new matter are present in independent claims 59 and 60 as well as any dependent claim that references this new language.

Claim 43 as amended also refers to the annular reinforcing structures being applied against end flaps of the strip sections of the first series and overlapped by end flaps of the second series. While this language does seem to be originally described, the continued

Art Unit: 1733

presence of claim 44 indicates that it is apparently intended that claim 43 be read more broadly that what is described in claim 44 – to the extent claim 43 can be so read, such is not described in the original disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is likewise considered to be new matter. A 35 USC 112, second paragraph rejection will also be made in light of this ambiguity. An analogous lack of description/new matter issue is presented by claims 60/61.

In the last two lines of claim 59 as amended, reference is newly made to the second elastomer (i.e. of the filling) being the same as or different than the first elastomer (i.e. of the carcass strip sections). It however is not seen where the original disclosure describes this new requirement and no support has been pointed to by applicant. As such, it is considered that this was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter.

4. Claims 43-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, claim 43 as amended refers to the annular reinforcing structures being applied against end flaps of the strip sections of the first series and overlapped by end flaps of the second series. While this language does correspond to the originally described methodology of forming the sandwiched annular reinforcing structure, it would

Art Unit: 1733

seem that this methodology is simply another way of describing the spatial relationship as defined in dependent claim 44 and thus it is not considered that claim 44 further limits claim 43, it being noted that to the extent that it is considered that it does further limit, then it is not entirely clear what the scope of protection of claims 43 is then intended to be in this regard. An analogous ambiguity is presented by claims 60/61. Claim 59 has also been included within this rejection as it uses similar language to that use in claim 43 and thus is considered indefinite for the same reasons. In summary, it would seem that claims 43, 59 and 60 are relying upon the originally described method for descriptive support whereas claims 44 and 61 rely on original descriptive support of the resulting structure – there however is no indication that these are in fact intended to be different descriptions but rather were seemingly simply a way to describe the method and a way to describe the final product. Defining the final product as further limiting the claims referring to the method is thus again considered to present significant ambiguity in determining the scope of protection afforded by these claims.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 43-75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,457,504. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the conflicting claims do not provide specific details of how the filling material is joined to the reinforcing coils, it is considered obvious in this art to provide the filling body radially outside the annular coil reinforcement insofar as it is extremely common and typical to provide a bead filler outside the wire bead reinforcement. Likewise, it is considered obvious to apply the patent teachings to any known tire carcass including those for two wheeled vehicles.

7. Applicant's arguments filed July 15, 2003 have been fully considered and, when read in light of the amendments to the claims, are sufficient to overcome the rejections of record. However several new rejections were necessitated by the amendment.

In particular, the previous new matter/lack of description rejections have been withdrawn in light of applicant's response. However, significant new 35 USC 112, first and second paragraph rejections were necessitated. Also, it is agreed that the amendments to the claims overcome the prior art rejections of record. It is noted for the record that the examiner is reading the terms "strip sections" as well as the "end flaps" of these sections consistent with the original disclosure and thus as being considered to require each strip section be a separate and distinct entity extending between end flaps and not a continuous strip with other strip sections. This helps define particularly over references such as Frazier (US 3,240,250) which are directed to a continuous strip forming the carcass.

Art Unit: 1733

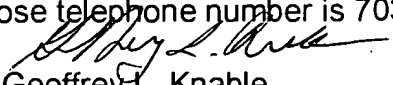
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. With respect to the obviousness double patenting rejection, it is noted that the broadening out of the requirement for the filling body necessitated this new ground of rejection (it being also noted that the conflicting patent was cited in the 7-15-03 IDS accompanied by the fee). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
October 5, 2003